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No. 09-326

Supreme Court, U.S.
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# In The Supreme Court of the United States

SUZAN S. HARJO, ET AL.,

*Petitioners,*

v.

PRO-FOOTBALL, INC.,

*Respondent.*

**On Petition For Writ Of Certiorari To The United States Court Of Appeals For The District Of Columbia**

## BRIEF OF LAW PROFESSORS AS *AMICI CURIAE* IN SUPPORT OF THE PETITIONERS

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## INTEREST OF THE *AMICI CURIAE*

This brief is filed on behalf of the undersigned Law Professors identified in Appendix A.[1]

*Amici* are scholars at U.S. law schools whose research and teaching focus is intellectual property law, federal Indian law and constitutional law. *Amici* have no direct interest in the outcome of this litigation. *Amici* are concerned that the Court of Appeals decision below is inconsistent with the well settled law that laches does not apply to trademark cancellation claims, including those based on disparagement, because of the strong public interest in being free from the harms that disparagement causes. These harms, which include damaging stereotyping and stigmatization, are serious and deserve protection no matter what private harm may be caused by delay to the trademark registrant. Further, precluding laches in these cases protects the government's interest in assuring the integrity of the Trademark Register. *Amici* urge this Court to grant review of this matter to clarify that laches cannot apply to a disparagement cancellation claim. Such a ruling will increase certainty for trademark holders, individuals and groups

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[1] The parties were timely notified of the intent to file this amicus brief pursuant to Rule 37.2. Letters of the parties' general consent to file are on file with the Court. This brief was not authored in whole or in part by counsel for any party. No one other than *Amici* and their counsel made a monetary contribution to preparing or submitting this brief. *Amici*'s institutional affiliations are provided only for purposes of identification.

claiming or subject to disparagement, and promote the larger public interest inherent in these claims.

## SUMMARY OF THE ARGUMENT

Disparagement claims belong in the category of trademark cancellation claims that are not subject to laches defenses because the harm to the public in the continued registration of the mark outweighs any private harm that may be caused by the delay. This exception categorically precludes application of the laches defense and does not require a balancing of the equities that occurs in ordinary cases involving a laches defense. Courts have recognized that the equitable defense is inapplicable in disputes in which there is a public harm caused by the continued registration and enforcement of the mark.

Disparagement claims explicitly target the public harms of perpetuating offensive stereotypes. If laches defenses are barred in cancellation claims that only implicitly protect the public, then that doctrine clearly extends to cancellation claims that explicitly protect the public from harm.

## ARGUMENT

### I. Disparagement Claims Are Not Subject to Laches Defenses

Disparagement claims belong in the category of trademark cancellation claims that are not subject to laches defenses because the harm to the public in the continued registration of the mark outweighs any private harm that may be caused by the delay. It is settled law that laches, even if proven, will not defeat numerous cancellation claims. 3 Thomas J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 20:77 (4th ed. 2009); *Kaiser Aluminum & Chem. Corp. v. Am. Meter Co.*, 153 U.S.P.Q. 419 (T.T.A.B. 1967) ("The equitable principles of laches and estoppel are inapplicable where the registration of a descriptive term is involved."); *Philip Morris Inc. v. He-Man Prods., Inc.*, 157 U.S.P.Q. 200 (T.T.A.B. 1968) ("[I]t is a well established principle of trademark law that the equitable defense of laches and estoppel is not available in a proceeding wherein, as here, the adverse party is claiming that the designation in question inherently cannot function as a trademark for the goods in question under the trademark statute."); *Am. Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 U.S.P.Q. 149 (T.T.A.B. 1973) ("While this testimony might well conjure up the equitable defense of estoppel and laches, it may be appropriate to point out that these equitable defenses are not available to a defendant in a proceeding wherein, as here, the adverse party is claiming in essence that the mark in question inherently cannot function as a trademark

under the statute . . . The rationale behind these series of cases is that it is within the public interest to have registrations which are void *ab initio* striken from the register and that this interest or concern cannot be voided by the inaction of any single person or concern, no matter how long the delay persists."); *Saint-Gobain Abrasives, Inc. v. Unova Indus. Automation Sys., Inc.*, 66 U.S.P.Q.2d 1355, 1359 (T.T.A.B. 2003) ("It is well-established that the equitable defenses of laches and acquiescence are not available against claims of genericness, descriptiveness, fraud and abandonment. . . . For the same reason, we hold that where the proposed ground for opposition and cancellation is functionality, the defenses of laches and acquiescence are unavailable."); *Midwest Plastic Fabricators, Inc. v. Underwriters Labs., Inc.*, 5 U.S.P.Q.2d 1067, 1069 (T.T.A.B. 1987) ("[T]he defense of laches is not available where the petition to cancel is based on a claim that a respondent has failed to control the use of a certification mark, such that the mark is being used to certify goods that do not meet specified standards. . . . The public interest in certification marks and the assurance that registered certification marks are being properly controlled outweighs any possible injury to the respondent resulting from inaction by petitioner."). As this doctrine has developed in the courts, these claims include: 1) the claim of inevitable confusion;[2] 2) the

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[2] *See Chun King Corp. v. Genii Plant Line, Inc.*, 403 F.2d 274, 276 (C.C.P.A. 1968); *Ultra-White Co. v. Johnson Chem.*

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claim that the mark is generic;[3] 3) the claim that the registration was fraudulently obtained;[4] 4) the claim that the mark has been abandoned;[5] 5) the claim that the mark is functional;[6] and 6) the claim of lack of control over a certification mark.[7] In each of the cancellation claims to which this doctrine applies, any injury to the registrant caused by the petitioner's delay in bringing the claim would be outweighed by the anticipated injury to the public caused by the continued registration of the mark.

These exceptions go beyond the ordinary balancing of the equities that occurs in any case involving a laches defense to categorically preclude application of the doctrine. In cases in which these cancellation claims

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*Indus., Inc.*, 465 F.2d 891, 893-94 (C.C.P.A. 1972); *Richdel, Inc. v. Mathews Co.*, 190 U.S.P.Q. 37, 41 (T.T.A.B. 1976).

[3] *See Steinberg Bros., Inc. v. J. P. Stevens & Co.*, 156 U.S.P.Q. 574, 579-80 (T.T.A.B. 1967); *Am. Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 U.S.P.Q. 149, 156 (T.T.A.B. 1973); *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 146 U.S.P.Q. 313, 316 (T.T.A.B. 1965).

[4] *See Treadwell's Drifters, Inc. v. Marshak*, 18 U.S.P.Q.2d 1318 (T.T.A.B. 1990).

[5] *See Linville v. Rivard*, 41 U.S.P.Q.2d 1731, n.5 (T.T.A.B. 1997), *aff'd on other grounds*, 133 F.3d 1446 (Fed. Cir. 1998); *Empresa Cubana Del Tabaco v. Culbro Corp.*, 213 F. Supp. 2d 247, 266-67 (S.D.N.Y. 2002).

[6] *See Saint-Gobain Abrasives*, 66 U.S.P.Q.2d at 1359.

[7] *See Midwest Plastic Fabricators*, 5 U.S.P.Q.2d at 1069 ("The defense of laches is not available where the petition to cancel is based on a claim that a respondent has failed to control the use of a certification mark.").

are made, courts do not wade into an evaluation of the public harm versus the private harm in the application of a laches defense. Because of the nature of the cancellation claim, the public harm will necessarily outweigh the private harm and laches cannot therefore be asserted.

The interest of the public in being protected against the registration of marks that would cause it injury must forestall the application of this equitable defense. Courts have recognized that the equitable defense is inappropriate in disputes in which there is a public harm in addition to the private injuries asserted by the parties. Thus, in cases involving marks that cause inevitable confusion in the marketplace and certification marks that no longer accurately certify a characteristic about a good or service, not only would the private claimants be injured, but the public would also be harmed by the misleading information caused by the registered mark. Likewise, in the cases of generic, functional, abandoned and fraudulently obtained marks, not only would the private claimants be injured, but the public would also be injured by the barrier to competition caused by the registered mark. Thus a number of cancellation claims covered by this doctrine protect the public by protecting consumers or by protecting competition.

In this way, in each of the cancellation claims where laches has been found not to apply, the courts have identified a harm to the public that is in addition to the harm to the private party that would

likely be caused by the continued registration of the mark. In these cases, courts have held that the equitable defense of laches was inapplicable due to the additional presence of the public harm.[8] The doctrine that emerges from these cases is that laches is not available as a defense where there is a significant public harm likely to result from the continued registration of the mark.

If this exception to laches is to be maintained on the basis of public harm, then cancellation claims of disparagement must be brought within it. The protection from disparaging marks is aimed principally at the public. In disparagement cancellation proceedings, the public is not an additional beneficiary of the claim brought as a result of private motivations, as is the case in the other claims that have been held to preclude a laches defense.[9] Instead,

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[8] *See Chun King Corp. v. Genii Plant Line, Inc.*, 403 F.2d at 276; *Ultra-White Co. v. Johnson Chem. Indus., Inc.*, 465 F.2d at 893-94; *Richdel, Inc. v. Mathews Co.*, 190 U.S.P.Q. at 41; *Steinberg Bros., Inc. v. J. P. Stevens & Co.*, 156 U.S.P.Q. at 579-80; *Am. Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 U.S.P.Q. at 156; *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 146 U.S.P.Q. at 316; *Treadwell's Drifters, Inc. v. Marshak*, 18 U.S.P.Q.2d at 1318; *Linville v. Rivard*, 41 U.S.P.Q.2d at n.5; *Empresa Cubana Del Tabaco v. Culbro Corp.*, 213 F. Supp. 2d at 266-67; *Saint Gobain Abrasives*, 66 U.S.P.Q.2d at 1359; *Midwest Plastic Fabricators*, 5 U.S.P.Q.2d at 1069.

[9] In only three disparagement cases was a private harm even present. *See Doughboy Indus., Inc. v. The Reese Chem. Co.*, 88 U.S.P.Q. 227, 228 (1951) (holding the mark "Doughboy" when used on prophylactic preparations for the prevention of venereal disease may disparage or falsely suggest a connection with

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in disparagement claims, the first and only objective is to protect the public from harm.[10] Unlike the cancellation claims in which the courts analyzed and articulated an additional public harm beyond the private harm, in disparagement claims the public harm is the only harm contemplated. Thus disparagement claims are the archetypical public interest claims. If laches defenses are barred in cancellation claims that implicitly protect the public, then that doctrine clearly extends to cancellation claims that explicitly protect the public.

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American WWI soldiers); *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635, 1639-41 (T.T.A.B. 1988) (finding the applicant's defecating dog mark to be disparaging because the mark would be considered generally offensive by a substantial portion of the public and would be recognized by the public as referring to the Greyhound Corp.); *Boston Red Sox Baseball Club Ltd. P'ship v. Brad Francis Sherman*, 2008 TTAB LEXIS 67, 22-29 (T.T.A.B. 2008) (finding the applicant's SEX ROD mark to be disparaging because the mark would be perceived by a substantial composite of the public as vulgar and the public would associate the offensive mark with the Boston Red Sox). In each of these cases, a mark owner stood in to vindicate the public's right. Significantly, these cases were brought under a claim of disparagement, in which the public's sensibilities are at stake, and not a claim of dilution by tarnishment, in which only the mark owner's sensibilities are relevant.

[10] *See Bromberg, et al. v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. 176, 179 (T.T.A.B. 1978) (In finding that two female opposers had standing to challenge the applicant's "ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND" mark on behalf of the female segment of the public, the T.T.A.B. stated: "In the past, marks have been refused registration by the examiner [under § 2(a)] on the ground that they were offensive to a certain segment of the public.").

Unlike cancellation claims of confusion, fraud, abandonment, functionality, and genericism, which occur with great frequency before the courts,[11] disparagement claims are rare.[12] Only a few disparagement claims have been litigated outside of the Trademark Trial and Appeal Board,[13] and half have been *ex parte* proceedings in which the United States Patent and Trademark Office asserts the prohibition on behalf of the public.[14] Due to the dearth of disparagement cases generally, it is not surprising that no court has yet

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[11] *See* 6 *McCarthy on Trademarks* § 31:60 (noting that defendants in many trademark infringement suits pursue claims of fraud); 3 *McCarthy on Trademarks* § 17:4 (explaining that abandonment claims are significant in a number of legal situations).

[12] Only fourteen disparagement cases have been decided on their merits. *See In re Old Glory Condom Corp.*, 26 U.S.P.Q. 1216, 1221 n.4 (T.T.A.B. 1993) (noting existence of "little precedent on the meaning of 'disparage' in Section 2(a)"); 3 *McCarthy on Trademarks* § 19:77.1 ("There is very little case law on what constitutes a mark that disparage[s] a racial or ethnic group.").

[13] *See Pro-Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009); *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999); *McDermott v. San Francisco Women's Motorcycle Contingent*, 240 Fed. Appx. 865 (Fed. Cir. 2007).

[14] *See, e.g., In re Anti-Communist World Freedom Cong., Inc.*, 161 U.S.P.Q. 304 (T.T.A.B. 1969); *In re Condas, S.A.*, 188 U.S.P.Q. 544 (T.T.A.B. 1975); *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d 1653 (T.T.A.B. 1990); *In re Hines*, 31 U.S.P.Q.2d 1685 (T.T.A.B. 1994); *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264 (T.T.A.B. 2006); *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008).

held that the laches defense is inapplicable in cancellation petitions involving disparagement claims.[15] The absence of precedent in no way undermines the consistent application of the rule that laches does not apply in cases involving public harms.

Not every case in which an argument can be made that the public has an interest should be included in this doctrine. Obviously the exception would swallow the rule were courts to extend the doctrine every time a claimant argued that they were standing in on behalf of the public's interest in an efficient marketplace. In addition to the cancellation claims set out above that have already been ruled to be within this exception, the only other cancellation claims that ought to be included are those that are explicitly oriented to protecting the public.

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[15] Cancellation claims that marks are either scandalous or immoral are also rarely litigated claims that should not be subject to laches defenses because of the public's interest in prohibiting such marks. 15 U.S.C. § 1052(a). No court has yet been asked to apply a laches defense to such a claim. Unlike claims of disparagement, immorality and scandalousness, which are all aimed at protecting the public, a claim that a mark falsely causes a connection may address a private or public harm depending on whether the false connection is made to an individual or to a group. *See In re White*, 80 U.S.P.Q.2d 1645 (T.T.A.B. 2006) (refusing registration of MOHAWK for cigarettes because it would falsely suggest a connection with the St. Regis Band of Mohawk Indians of New York).

Section 2(a) of the Lanham Act contains a number of claims that may be asserted in a cancellation proceeding. All of the claims assert paramount public interests that should preclude application of laches to the claims. Among other things, this section prohibits the registration of a mark that "consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute. . . ." 15 U.S.C. § 1052(a). Each of these claims addresses the public's interest and should be immune to laches defenses.

## II. Disparaging Marks Harm the Public

Protection against trademark disparagement has been understood in various ways to prevent harm to the public. The relevant concerns include protection of a privacy interest, as in "the right to be 'let alone' from contempt and ridicule,"[16] and the belief that "group libel" is an actionable harm. *See generally Beauharnais v. Illinois,* 343 U.S. 250 (1952). At its core, the prohibition against registration of disparaging marks protects against the perpetuation of offensive stereotypes about a particular group. *See In re Hines*, 31 U.S.P.Q.2d at 1691 (holding that applicant's depiction of Buddha dressed in a bathing suit

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[16] *See Greyhound Corp.*, 6 U.S.P.Q.2d at 1639 (citing *Carson v. Here's Johnny Portable Toilets Inc.*, 698 F.2d 831 (6th Cir. 1983)).

sprawled across loungewear "slights, depreciates and cheapens Buddha and Buddhism"); *In re Heeb Media, LLC*, 89 U.S.P.Q.2d at 1073, 1077 (explaining that the term "Heeb" is a derogatory term for a person of Jewish descent and cannot be registered as a trademark because it offends a substantial composite of the relevant group).

Although the legislative history of the enactment of the disparagement claim under Section 2(a) of the Lanham Act is scant, the present U.S. prohibition on the registration of marks that harm the public derives from the first major multilateral trademark treaty in force in the late nineteenth century. The authoritative Paris Convention in its first iteration in 1883 provided only one acceptable ground for the refusal of trademark registrations, which was when a mark was considered contrary to morality or public order.[17] A mark contrary to public order has been defined as one that is contrary to basic legal or social concepts.[18] Section 2(a) of the Lanham Act mirrors and implements the concern for morality and public

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[17] "[T]he only ground for refusal or invalidation of the registration of trademarks covered by Article 6," which set forth the conditions of registration and the independence of registration of the same mark in different countries, was if "the object for which it is requested is considered contrary to morality or public order." *See* G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property* 114 (1968) (citing Actes de Paris, I. pp.73-74, 138).

[18] *See id.*, at 116 (listing examples including a mark containing a religious symbol, the emblem of a forbidden political party, or the emblem of a public body).

order in the Paris Convention,[19] as it refuses to permit or maintain the registration of marks that are "immoral, deceptive, or scandalous" or which "may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute." *See* 15 U.S.C. § 1052(a).

While trademark law most often measures economic harms, the underlying notion in these categories of prohibited marks is to protect against the perpetuation of unflattering stereotypes about a particular group and the harms to both its members and the public at large. As the T.T.A.B. found in this case below, "there exists a broader interest – an interest beyond the personal interest being asserted by the present petitioners – in preventing a party from receiving the benefits of registration where a trial might show that respondent's marks hold a substantial segment of the population up to public ridicule."[20] While the injury to the members of the group is self-evident, the social costs to the public at large may include reinforcing hateful and erroneous stereotypes and misinformation about a certain group. The harm is at once to the referenced group and also to

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[19] The United States is a signatory to the Paris Convention. *See* Jasmine Abdel-khalik, *To Live in In-"fame"-y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 Cardozo Arts & Ent. L.J. 173, 186 (2007) (noting that Congress examined foreign trademark laws before passing the 1905 Act and suggesting Congress was significantly influenced by international registration regimes).

[20] *Harjo v. Pro-Football, Inc.*, 30 U.S.P.Q.2d 1828, 1830 (T.T.A.B. 1994).

society as a whole. *See In re Heeb Media*, 89 U.S.P.Q.2d at 1074.

The effects of trademarks are not limited to their role to "identify and distinguish" goods or services, but importantly they have unique power to shape, reflect, and comment upon social identities.[21] In this way, disparaging marks, with their power to stigmatize a group or individual, pose a serious threat to the larger common good for both stigmatized groups and society as a whole. The term "stigma" itself refers to a mark placed on an individual to signify infamy or disgrace.[22] Those associated with stigmas are not viewed as normal, but different, flawed, or undesirable.[23] The public as a whole suffers from stigmatizing individuals or groups, as the public typically constructs a false ideology to explain the stigmatized group's inferiority and rationalize society's animosity toward it.[24] Studies demonstrate that "bias can be exacerbated or mitigated by the information environments we inhabit," and that "consuming negative images can exacerbate implicit bias."[25]

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[21] *See* Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 Notre Dame L. Rev. 397, 397 (1990).

[22] James Flynn et al., *Risk, Media, and Stigma* 3 (2001).

[23] *See id.*, at 14.

[24] Erving Goffman, *Stigma: Notes on the Management of Spoiled Identity* 5-6 (1986).

[25] Jerry Kang, *Trojan Horses of Race*, 118 Harv. L.Rev. 1490, 1557, 1561 (2005).

## III. Disparaging Marks Harm the Government's Interest in Protecting the Integrity of the Register of Trademarks

The prohibition on registering and maintaining disparaging marks also has been found to further the government's interest in protecting the integrity of the Register of Trademarks. Courts are mindful that trademark registration confers distinct legal advantages over common-law marks, including "prima facie evidence" of validity in subsequent cancellation proceedings.[26] To protect the public from confusion over the source of goods, it is crucial to determine the validity of trademarks listed on the Federal Register to ensure that these benefits are not granted improperly.[27] Moreover, the federal government should not waste its valuable resources on protecting invalid marks.[28] The government should also not provide its imprimatur through federal registration of marks that are void *ab initio*, such as those found to be

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[26] 3 *McCarthy on Trademarks and Unfair Competition* §19:9.

[27] In evaluating the validity of a disputed trademark, courts must consider that the "interests [of the public] are paramount" in this calculus. 1 *McCarthy on Trademarks* § 2:33 n.5 (citing *James Burrough, Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 274 (7th Cir. 1976)). *See Nestle Co., Inc. v. Chester's Market, Inc.*, 596 F. Supp. 1445, 1454 (D. Conn. 1984) (explaining that "protection of the public is a primary goal" of the regulatory framework).

[28] *See Dwinell-Wright Co. v. Nat'l Fruit Product Co., Inc.*, 129 F.2d 848, 853 (1st Cir. 1942) (explaining that there is a "waste and duplication of effort" associated with repeated litigation over the same issue.).

disparaging.[29] This is particularly true here where the government has an interest in preventing its instrumentalities from being used to perpetuate and enforce offensive stereotypes.[30] Safeguarding the integrity of the Trademark Register is an important public policy goal that has been vindicated in judicial decisions along with the injury to parties challenging a registered trademark.[31]

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[29] *See In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981) ("We do not see . . . [the refusal to register such marks] as an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government.").

[30] *See Shelley v. Kraemer*, 334 U.S. 1, 20 (1948) ("[w]hen the effect of . . . [government] action is to deny rights subject to the protection of the Fourteenth Amendment, it is the obligation of this Court to enforce the constitutional commands.").

[31] *Marshak v. Treadwell*, 240 F.3d 184, 194 (3d Cir. 2001); ("[T]he interest vindicated by Section 14 is not just the injury to the challenging party, but the integrity of the register."); *Harjo*, 30 U.S.P.Q.2d at 1831 ("The Board has held that the equitable defenses of laches and estoppel are not available against claims of fraud and abandonment because there exists a broader interest – a 'public policy' interest – in addition to a private interest in removing from the register those registrations procured or maintained by fraud and those registrations for marks that have been abandoned."); *TBC Corp. v. Grand Prix Ltd.*, 12 U.S.P.Q.2d 1311, 1313 (T.T.A.B. 1989) ("Where the proposed ground for cancellation is abandonment, equitable defenses should be unavailable for the same reason they have been held unavailable when the ground asserted is descriptiveness or fraud. It is in the public interest to remove abandoned registrations from the register.").

## CONCLUSION

For the foregoing reasons, this Court should grant review of this matter to clarify that the doctrine of laches is inapplicable to trademark cancellation petitions where there is a public harm caused by continued registration of the mark.

Respectfully submitted,

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